

REMARKS**Paragraph 1 of the Office Action**

Claim 1 is rejected under 35 USC §112 second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1 and 5 have been amended in a manner believed to remove any confusion.

Withdrawal of the rejection is respectfully requested by the applicant.

10

Paragraph 2 of the Office Action

Claim 1 is rejected under 35 USC §102(b) as being anticipated by U.S. Patent Number 6,116,628 to Adrian.

It is respectfully submitted to the Examiner that Adrian does not teach a device that is secured to a mud flap and that is removably attachable to a vehicle but instead teaches a bracket that is secured to a vehicle and to which a mud flap may be removably attached. Applicant's device is a mud flap that may be quickly attached to any vehicle, and particularly trailers, when then they are being used and have not yet been equipped with mud flaps. For that reason, unlike Adrian, applicant has attached, not removably attached, the brackets to the mud flap (panel). Adrian teaches a, "Holder 20 ... *attached directly to the trailer frame or to a bracket mounted on the frame.... Holder 20 is typically bolted to the vehicle or frame, generally by bracket 37 that has holes 46 there through.*" Column 5, lines 20-28 (emphasis added). Further, Adrian specifically states that it is the mud flap that is removably mounted to the holder 20 and not the holder to the vehicle. "The present invention is a new and improved holder for securing mud flaps to a vehicle. *Rather than bolting the flap to a holder, the flap is held in the holder by a compressive force provided by a spring.*" Column 1, lines 61-65 (emphasis added). That the Examiner has cited clamps, generally, is not enough. The clamps of applicant's device are attached to the mud flap whereas the holder (clamp) of Adrian is attached to the vehicle. The two are not analogous and therefore it is submitted that claims 1, 5 and all claims depending from claim 1 are in condition for allowance.

Withdrawal of the rejection is respectfully requested by the applicant.

Paragraphs 3 and 4 of the Office Action

Claims 3, 4 and 5 are rejected under 35 U.S.C. §103(a) as being unpatentable over 5 Adrian in view of U. S. Patent No. 5,048,868 to Arenhold.

With respect to claim 3, applicant's device includes a plurality of clamps because the multiplicity of clamps allows for contours in the rail to which they are being attached. If only one clamp were used, the entire clamp would have to fit on the rail or the user would risk the device falling off of the rail. A plurality of clamps allows the mud flap to 10 be positioned in a manner that ensures a majority of the clamps have a secure hold of the rail while the mud flap is properly positioned behind a wheel. Since this is a structural difference that leads to a functional improvement, the additional clamps are not routine as found within the meaning of *Howard v. Detroit Stove Works*.

As to Arenhold, it is respectfully submitted to the Examiner that the *Graham* test 15 for obviousness has been modified and now also includes a motivation component.

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so.' [citation omitted] Although 20 couched in terms of combined teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious "modification" of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification.

25 In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992), (in part quoting from ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577; 221 USPQ 929, 933 (Fed. Cir. 1984)).

In the present case, the Examiner has simply chosen to find elements that do not have any relationship to each other and then has combined the references in order to 30 piece together applicant's device as though one were checking items off of a shopping list. This may be permissible were there motivation to make the combination of the elements, however, there cannot be any such motivation or suggestion here. The posts of applicant's device extend through the mud flap to secure the mud flap to the bracket. The Examiner cites this type of connection in Arenhold, though Arenhold does not show or

suggest posts extending through the bracket and the panel, to be combined with Adrian. However, Adrian has no use for such a connection, as it would prevent the Adrian device from being functional. The Adrian device requires the mud flap to be removable from the holder. Extending posts through the holder and then the flap would prevent this from happening and would also negate the clamping function of Adrian's holder. Since the two devices cannot be combined as they teach structures having opposite manners of functionality, there can be no motivation to make the combination.

Further, it is respectfully submitted that the Examiner has implied broader definitions in an effort to overly broaden the clearly stated structures of both applicant's device and those devices of the referenced citations. Such an over broadening of the elements is evidence of hindsight reconstruction.

Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine prior art references. See, e.g., C.R. Bard, Inc. v. M3 Sys., Inc. , 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232 (Fed. Cir. 1998).

In re Dembicczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999). Here the Examiner has simply listed a plurality of non-connected elements that, if connected, would not function as required by either of the sources of those elements. Since combining the limitations of Arenhold to Adrian would prevent the proper functioning of Adrian, and since the combining of the structure and function of Adrian to Arenhold would prevent Arenhold from being removable, there cannot be any motivation within those references to support their combination.

For the above reasons, it is believed that claims 3, 4 and 5 are in condition for allowance.

The applicant respectfully requests withdrawal of the rejection.

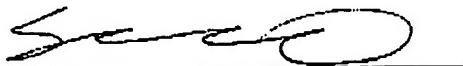
CONCLUSION

5

In light of the foregoing amendments and remarks, early consideration and allowance of this application are most courteously solicited.

Respectfully submitted,

10



Sean A. Kaushold (Reg. No. 46,820)
P.O. Box 89626
15 Sioux Falls, SD 57109
(605) 334-1571 FAX (605) 334-1574

Date: 7/22/05